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10/734,400	12/12/2003	Mary Archuleta Heckle	2003P01535 US01	1178

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Alexander J. Burke  
Intellectual Property Department  
5th Floor  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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02/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,400	<b>Applicant(s)</b> HECKLE, MARY ARCHULETA	
	<b>Examiner</b> Tran Nguyen	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/12/2003</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

This communication is in response to the communication filed 01/08/2008.

Pending claim(s): 1-15, 19. Non-elected claim(s): 16-18.

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-15, 19 in the reply filed on 01/08/2008 is acknowledged.

### ***Priority***

Acknowledgment is made of Applicant's claim for priority to application 60444829 filed 02/04/2003.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 12/12/2003 is entered and considered by Examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 9-12 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 9 recites the broad recitation "documents", and the claim also recites "a collator" which is the narrower statement of the range/limitation.

Applicant defines "a document" to be "a physical and/or electronic collection of related data elements" (page 2 paragraph 7). Applicant further defines "a collator" to be "a device for sorting physical documents" (page 4 paragraph 15).

As recited, “documents” could encompass both physical and electronic data, whereas “a collator” is limited to physical documents, as defined by Applicant.

For purposes of applying prior art, Examiner interprets claim 9 to recite processing physical documents.

Claims 10-12 recite the limitation "said collator". There is insufficient antecedent basis for this limitation in the claim.

For purposes of applying prior art, Examiner interprets claims 10-12 to depend on claim 9.

These claims are also rejected for the same rationale as applied to claim 9 above, through dependency, and incorporated herein.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a system comprising “a document processor” and “an output processor”. While Examiner recognizes that the recited system is

capable of processing a "document", Applicant defines "a document" to be "an electronic collection of related data elements" (page 2 paragraph 7). Applicant further defines "a processor" to be "a set of machine-readable instructions for performing a task. A processor comprises any one of.... software" (page 3 paragraph 14).

When read in light of the specification and the level of ordinary skill in the art, Examiner submits that claim 1 is directed towards software *per se*, and is therefore nonstatutory. See MPEP 2106.01(I).

Examiner appreciates that the scope of claim 1 may also envelop hardware embodiments; however, claim 1 also envelops software *per se* embodiments, and is therefore nonstatutory.

All claims dependent thereon, namely claims 2-8, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1-2, 5-8, 19 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (5664109).

As per claim 1, Johnson teaches a system (column 1 line 9) capable of processing data (column 1 line 8) representing medical record documents (Abstract), wherein the medical record documents are generated by health care providers grouped as a network (reads on "a healthcare organization") (column 1 line 30-39) in treating patients (reads on "a patient encounter") (column 1 line 12-28), comprising:

(a) hardware and software (reads on "a document processor") (Figure 1) capable of:

(i) receiving a patient medical record document (reads on "a document representing a record associated with a patient encounter with a healthcare organization") (Figure 2 label 208);

(ii) assigning tags (reads on "appending identifiers") to identified elements (Figure 4 label 414), comprising:

(a) type and source of document (reads on "an encounter identifier") (column 9 line 15-37);

(b) a patient medical record number (column 9 line 38-65);

(c) sections of a document (reads on "a patient record section identifier") (column 10 line 1-20);

(b) hardware and software (reads on “an output processor”) (Figure 1) capable of storing the document and tags in a database (Figure 2 label 216) for output to an application (Figure 2 label 220).

As per the set of claim(s): 2, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

As per claim 5, Johnson teaches interactive extraction of the tags discussed in the rejection of claim 1 above (reads on “user selection and entry”) (Figure 4 label 410).

As per claim 6, Johnson teaches processing documents in response to:

- (a) an admission form (column 9 line 18);
- (d) a discharge summary (column 9 line 26).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of “at least one of”.

As per claim 7, Johnson teaches software and hardware (reads on “an identification processor”) capable of extraction processing (Figure 2 label 212, 214).

As per claim 8, Johnson teaches that the system is capable of assigning tags after identifying the source and type of document (Figure 4 label 414).



As per the set of claim(s): 19, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 3-4, 9-15 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

As per claim 3, Johnson teaches receiving a hardcopy (column 6 line 44-55). Johnson further teaches converting the hardcopy to electronic format (column 6 line 45-

55), and is processed as discussed in the rejection of claim 1 above, and incorporated herein.

Johnson does not teach “imprinting said identifiers onto said [paper] documents”.

Johnson further teaches that the processed electronic medical record document may be printed and sent by physical mail or fax (column 15 line 15-19). Johnson further teaches displaying a digital image of the document (column 15 line 10-11). Johnson further teaches that the server is capable of reviewing the tags associated with a document before presenting the document for display (column 15 line 33-37).

Because Johnson teaches systems for processing electronic and hardcopy documents, it would have been obvious to one of ordinary skill in the art to substitute electronic for paper documents to achieve the predictable results of providing processed patient medical records.

As per claim 4, Johnson teaches using ASCII characters to identify the tags discussed above in claim 1 (reads on “characters” and “other codes”) (Figure 9).

As per claim 9, Johnson teaches a system (column 1 line 9) capable of listing data for a client (reads on “sorting”) (Figure 8 label 810) representing medical record documents (Abstract), wherein the medical record documents are generated by health care providers grouped as a network (reads on “a healthcare organization”) (column 1 line 30-39) in treating patients (reads on “a patient encounter”) (column 1 line 12-28), comprising:

(a) hardware and software (reads on “a document processor”) (Figure 1) capable of receiving a patient medical record document (reads on “a document representing records associated with a patient encounter with a healthcare organization”) (Figure 2 label 208);

(b) hardware and software (Figure 1) capable of storing the document and tags in a database (Figure 2 label 216) for output to an application (Figure 2 label 220), wherein tags are assigned to identified elements (Figure 4 label 414), comprising:

(a) type and source of document (reads on “an encounter identifier”) (column 9 line 15-37);

(b) a patient medical record number (column 9 line 38-65);

(c) sections of a document (reads on “a patient record section identifier”) (column 10 line 1-20).

Johnson further teaches receiving a hardcopy (column 6 line 44-55). Johnson further teaches converting the hardcopy to electronic format (column 6 line 45-55), and is processed as discussed above.

Johnson does not teach “a collator”.

Johnson further teaches that the processed electronic medical record document may be printed and sent by physical mail or fax (column 15 line 15-19). Johnson further teaches displaying a digital image of the document (column 15 line 10-11). Johnson further teaches that the server is capable of reviewing the tags associated with a document before presenting the document for display (column 15 line 33-37). Johnson

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further teaches that the client is able to query patient records (Figure 8, column 15 line 19-37).

Because Johnson teaches systems for processing electronic and hardcopy documents, it would have been obvious to one of ordinary skill in the art to substitute electronic for paper documents to achieve the predictable results of providing processed patient medical records.

As per claims 10-12, Johnson teaches querying patient records based on a plurality of identifiers, including complex queries comprising fielded queries (column 15 line 19-37).

As per claim 13, this claim is rejected for the same rationale as cumulatively applied to claims 1, 9 above, and incorporated herein.

As per claim 14, this claim is rejected for the same rationale as cumulatively applied to claims 10-12 above, and incorporated herein.

As per claim 15, Johnson teaches storing information to access and use of the system by subscribers for security purposes (column 14 line 4-25).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Schoenberg (Internet based repository of medical records that retains patient confidentiality) teaches piecemeal access to patient record.

Veterans Health Administration (Patient Care Encounter (PCE) V. 1.0 User Manual) teaches patient encounter documentation.

Any inquiry concerning this communication or earlier communications from Examiner should be directed to Tran N. Nguyen (Ken) whose telephone number is (571) 270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, Examiner's Supervisor, Joseph Thomas can be reached on (571) 272-6776.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3626

02/15/2008

/Robert Morgan/

Primary Examiner, Art Unit 3626